

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

#### Status of the Claims

Claims 1-8 and 22 are pending; Claims 1 and 6 are amended; Claims 9-21 are canceled without prejudice or disclaimer; and Claim 22 is newly added. It is respectfully submitted that no new matter is added by this amendment.

#### Summary of the Office Action

In the outstanding Office Action, Claim 1 was rejected under 35 U.S.C. § 112, second paragraph; Claims 1, 9-15, and 17-21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dobbs et al. (U.S. Pat. No. 5,550,886, hereafter Dobbs); and Claims 2-8 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dobbs and further in view of Andrews (U.S. Pat. No. 6,778,636).

#### Rejection Under 35 U.S.C. § 112, Second Paragraph

With regard to the outstanding rejection of Claim 1 under 35 U.S.C. § 112, second paragraph, that rejection is respectfully traversed. The outstanding Office Action states at page 2 that Claim 1 should be amended to recite “means for in compliance with the statute.” However, the Applicants did not intend to invoke 35 U.S.C. § 112, sixth paragraph. Therefore, the Applicants did not use “means for” language. Because it is respectfully submitted that this claim is not indefinite under 35 U.S.C. § 112, second paragraph, it is respectfully requested that this rejection be withdrawn.

Rejection of Claims 1, 9-15, and 17-21 Under 35 U.S.C. § 103

The outstanding rejection of Claims 1, 9-15, and 17-21 under 35 U.S.C. § 103(a) as unpatentable over Dobbs is also respectfully traversed.<sup>1</sup>

In the past, when scanning ranges were set on an object, such as an internal organ of a patient, an opening of a collimator may be set according to the scanning range and the scan was performed of the internal organ. However, part of the internal organ was not always included in the scanning range. As a result, insufficient data was collected and repeated scans were necessary.<sup>2</sup>

At the outset, the outstanding Office Action admits that Dobbs fails to disclose or suggest at least one image processing part configured to generate volume data ... and at least one reconstruction part configured to reconstruct image data, as recited in Claim 1. Nonetheless, the outstanding Office Action alleges that these features would be obvious, without citing to any specific teachings in any reference to support this assertion of obviousness.

Thus, it appears that the outstanding Office Action has taken Official Notice that the claimed features are obvious. However, as set forth in MPEP § 2144.03, it is not appropriate for the Examiner to take Official Notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Moreover, it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principle evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001).

Because the outstanding Office Action has not provided any references to support the allegation of obviousness, it is respectfully submitted that the outstanding Office Action has not satisfied the requirements of MPEP § 2144.03.

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<sup>1</sup> Claims 9-15 and 17-21 have been canceled herewith, thereby rendering their rejection moot.

<sup>2</sup> Specification, paragraph [0004].

In addition, Claim 1 further recites a controller configured to set the opening of the collimator ... such that the second scanning range receives an amount of X-ray greater than an area external to the second scanning range, and a reconstruction part configured to reconstruct image data based on data collected by the second scan, including data from the second scanning area and external data from the area external to the second scanning area.

Because these features are not disclosed or suggested by Dobbs, it is respectfully submitted that independent Claim 1 and dependent Claims 2-8 patentably distinguish over Dobbs.

#### Rejection of Claims 2-8, and 16 Under 35 U.S.C. § 103

With respect to the rejection of Claims 2-8 and 16 under 35 U.S.C. § 103(a) as unpatentable over Dobbs in view of Andrews, that rejection is also respectfully traversed.<sup>3</sup>

As noted above, Dobbs does not disclose or suggest the features of independent Claim 1, from which Claims 2-8 depend. Andrews is not relied upon by the outstanding Office Action to remedy the above-identified deficiencies of Dobbs.

Even assuming, *arguendo*, that Andrews remedied the deficiencies of Dobbs, the outstanding Office Action has still not provided a *prima facie* case of obviousness. As set forth in MPEP § 2142, to establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The outstanding Office Action admits at page 5 that the applied combination does not teach all of the claim limitations. Despite this admission, the outstanding Office Action

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<sup>3</sup> Claim 16 has been canceled, thereby obviating its rejection.

asserts that the claimed features are obvious without citing to any authority to support this assertion.

Accordingly, if this rejection is to be maintained, it is respectfully requested that a reference be cited to support the assertion that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to compensate external data of the second scanning range with data collected by the first scan, to make use of all information from both scans collected.” Absent the citation of any reference in a future rejection of these claims, it is respectfully submitted that this rejection cannot be maintained.

Additionally, with respect to Claims 4 and 5, the outstanding Office Action asserts that the claimed features are inherent. However, the outstanding Office Action does not specify whether the claimed features are believed to be inherent within Dobbs, Andrews, or both.

As set forth in MPEP § 2112, “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Moreover, the mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

In light of the requirements set forth in MPEP § 2112, it is respectfully submitted that the outstanding Office Action has not shown that the claimed features are inherent in either of Dobbs or Andrews. As a result, the outstanding Office Action has not sustained the requisite level of proof necessary to support the outstanding rejection.

Because the outstanding Office Action has not provided a *prima facie* case of obviousness with respect to any of Claims 2-8, it is respectfully requested that the rejection of Claims 2-8 be withdrawn.

Moreover, it is respectfully submitted that there is no basis in the teachings of either of Dobbs or Andrews to support the applied combination. Certainly, the outstanding Office Action fails to cite to any specific teachings within either of these two references to support this combination. Thus, it is respectfully submitted that the combination of Dobbs and Andrews is the result of hindsight reconstruction in view of the teachings of the present specification, and is improper.

#### New Claim 22

Newly added Claim 22 recites features previously disclosed in the specification, for example, at paragraphs [0046] and [0050]. Accordingly, it is respectfully submitted that no new matter is added by Claim 22. Additionally, Claim 22 is believed to patentably distinguish over the applied references, as it recites features not disclosed or suggested by these references.

Conclusion

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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